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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Intermedia Advertising Group, Inc.
Serial No. : 76/092,228
Filed : July 19, 2000
Trademark : REWARDTV
Trademark Attorney : Ayisha Clarke
Law Office : 105

Assistant Commissioner for Trademarks
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07-17-2003

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APPELLANT'S APPEAL BRIEF

Applicant, Intermedia Advertising Group, Inc. hereby appeals from the refusal to register the mark REWARDTV for business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the Internet; and providing a website which features advertisements for the goods and services of others on the Internet in Class 35; and entertainment services, namely, providing an on-line computer game; entertainment services, namely providing information on-line about television programs in Class 41, and respectfully requests the Board to reverse the Examining Attorney's decision.

INTRODUCTION

Intermedia Advertising Group filed an intent to use application for the mark REWARDTV on July 19, 2000; and commenced use in connection with its services on August 1, 2001.

Registration was refused pursuant to §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the grounds that the mark was merely descriptive of Applicant's services.

The refusal to register should be reversed because the mark REWARDTV is suggestive of Applicant's business, consulting, and entertainment services and thus inherently distinctive and entitled to immediate registration on the Principal Register.

ISSUE

Is the mark REWARDTV suggestive when used in conjunction with business, consulting and entertainment services, or is the mark merely descriptive of these services?

ARGUMENT

I. THE MARK "REWARDTV" IS SUGGESTIVE OF APPLICANT'S BUSINESS, CONSULTING, AND ENTERTAINMENT SERVICES.

The mark REWARDTV, when used on and in connection with business, consulting, and entertainment services is suggestive, not merely descriptive.

A. REWARDTV is not readily recognizable as describing a particular characteristic of Applicant's services.

Applicant's services are business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the Internet; and providing a website which features advertisements for the goods and services of others on the Internet; and entertainment services, namely, providing an on-line

computer game; entertainment services, namely providing information on-line about television programs. **Applicant's services do not consist of providing "television related awards."**

To the contrary, Applicant conducts marketing and advertising services through a website that provides an on-line computer game. To play the game, consumers are required to watch specific television shows and answer a series of questions about the shows. They are awarded points for correct answers. The consumers can then redeem their points by entering sweepstakes to win prizes, which may not be related to TV, e.g. payment of an exorbitant phone bill, tickets to movie theaters, and gift cards for department stores. On the website, Applicant advertises its clients' products, which may also be awarded as prizes and offers to send further information about such products to the consumers.

Accordingly, Applicant's mark does not describe a particular characteristic or feature of Applicant's services.

In the On Technology case, the Board held:

"Applicant has created a word combination that is not readily recognizable as describing a particular characteristic of Applicant's goods. There is no such thing as an 'audit track' nor is there any action that can be termed an 'audit track.' One would never say that a computer program performs an 'audittrack or is capable of audittracking.' Thus, the mark AUDITTRACK does not convey any immediate and unambiguous meaning.
In re On Technology Corporation, U.S.P.Q.2d 1475, (TTAB 1996).

Similarly in the case at hand, Applicant has created a word combination that is not recognizable as describing a particular characteristic of Applicant's services. There is no such thing as a "rewardtv" nor is there any action that can be termed a "rewardtv." One would never say that Applicant's business, consulting, or entertainment services are "rewardtv" or that they are "rewarding tv."

Thus, under the criteria set forth in the On Technology case, *supra*, the mark REWARD TV is suggestive of Applicant's services.

B. Imagination, Thought or Perception is Required to Reach a Conclusion About Applicant's Services offered under the Mark REWARDTV.

The mark REWARDTV is suggestive because imagination, thought or perception is required to reach a conclusion about Applicant's services.

"Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used', or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.' " In re Gyulay, 3 U.S.P.Q.2d 1009, 1010 (CAFC 1987) quoting: In re Quik-Print Copy Shops, Inc., 205 U.S.P.Q. 505, 507 (CCPA 1980). "The categories are in actuality "central tones in a spectrum . . . and are frequently difficult to apply." Gyulay, supra, citing Soweco, Inc. v. Shell Oil, Co., 207 U.S.P.Q. 278, 282 (5th Cir. 1980), *cert. denied*, 450 U.S. 981, 101 S. Ct. 1516, 67 L. Ed. 2d 816, 210 U.S.P.Q. 76 (1981).

As noted above, Applicant conducts marketing and advertising services through a website that provides an on-line computer game. To play the game, consumers are required to watch specific television shows and answer a series of questions about the shows. They are awarded points for correct answers. The consumers can then redeem their points by entering sweepstakes to win prizes, which may not be related to TV, e.g. payment of an exorbitant phone bill, tickets to movie theaters, and gift cards for department stores. On the website, Applicant advertises its clients' products, which may also be awarded as prizes and offers to send further information about such products to the consumers.

Thus, to reach a conclusion about Applicant's services, consumers of Applicant's entertainment services must first perceive that the on-line game on the web site will require them to watch television and answer questions about the television shows watched. They will then need to perceive that they will be awarded points for answering the questions correctly, which can then be redeemed by entering a sweepstakes, where they can receive prizes. As such, imagination, thought and perception are required for consumer's to reach a conclusion about Applicant's entertainment services from the mark REWARDTV.

Even greater imagination, thought and perception will be required by the consumer's of Applicant's business and consulting services who must perceive that Applicant is going to do market research and advertising through promotional contests on the Internet, which will require participants to answer questions about recent television shows for which they will be awarded points for answering questions correctly, which can then be redeemable through a sweepstakes for prizes.

C. The Mark REWARDTV is Suggestive of Applicant's Services.

The composite mark REWARDTV is suggestive of Applicant's business, consulting, and entertainment services.

While it is proper to look at the individual elements of the mark, the determination of descriptiveness must be made with respect to the composite mark and not the individual elements. See: In re Hester Industries, Inc., 230 U.S.P.Q. 797 (TTAB 1986).

The suggestive nature of Applicant's composite mark is supported by decisions of the Court of Appeals for the Federal Circuit, its predecessor, the Court of Claims and Patents Appeals, and the Trademark Trial & Appeal Board, See, e.g., Bose Corp. v. International Jensen, Inc., 22 U.S.P.Q. 2d 1704 (Fed. Cir. 1992) [ACOUSTIC RESEARCH held to be suggestive for

loudspeakers]; In re Hutchinson Technology, Inc., 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988) [TECHNOLOGY held to be suggestive for electronic and mechanical computer components]; In re Majestic Distilling Co., 164 U.S.P.Q. 386 (CCPA 1970) [CHARRED KEG held to be suggestive for whiskey]; In re On Technology Corporation, supra [AUDITTRACK held to be suggestive for computer software for monitoring activity on a computer network]; Levi Strauss & Co. v. R. Joseph Sportswear, 28 U.S.P.Q.2d 1464 (TTAB 1993) [ACTION SLACKS held to be suggestive for pants]; In re Classic Beverage, Inc., 6 U.S.P.Q. 2d 1383 (TTAB 1988) [CLASSIC COLA held to be suggestive for soft drink]; No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 U.S.P.Q. 502 (TTAB 1985) [SHEER ELEGANCE held to be suggestive for panty hose]; In re Shop-Vac Corp., 219 U.S.P.Q. 470 (TTAB 1983) [WET/DRY BROOM held to be suggestive for electric vacuum cleaners]; Manpower, Inc. v. Driving Force, Inc., 212 U.S.P.Q. 961 (TTAB 1981) [DRIVING FORCE held to be suggestive for supplying truck drivers]; In re Polytop Corp., 167 U.S.P.Q. 383 (TTAB 1970) [LOC-TOP held to be suggestive for bottle closure caps]; In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (TTAB 1966) [HANDI WIPES held to be suggestive for dusting cloths]; and In re Colgate-Palmolive Co., 143 U.S.P.Q. 159 (TTAB 1964) [RAPID-SHAVE held to be suggestive for shaving cream].

Accordingly, the composite mark REWARDTV is suggestive of Applicant's services, not merely descriptive of the same.

II. ANY DOUBT ABOUT THE NATURE OF APPLICANT'S MARK SHOULD BE RESOLVED IN APPLICANT'S FAVOR.

It has long been held that "there is a very thin line of demarcation between a term that is merely descriptive and hence unregistrable in the absence of a showing of secondary meaning,

and one that is suggestive, and hence registrable, and it is often difficult to determine whether a particular term is on one side of the line or the other.” In re Aid Laboratories, Inc., 221 U.S.P.Q. 1215,1216 (TTAB 1983), citing In re TMS Corporation of America, 200 U.S.P.Q. 57 (TTAB 1978). See also: In re Atavio, 25 U.S.P.Q.2d 1361 (TTAB 1992). However, “where there is doubt on the matter, the doubt should be resolved in applicant’s behalf and the mark should be published in accordance with Section 12(c) of the Statute for purposes of opposition.” Aid Laboratories, 221 U.S.P.Q. at 1216 and the cases cited therein.

CONCLUSION

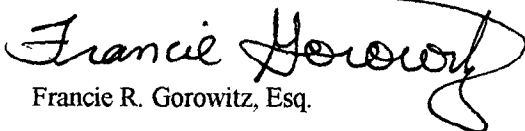
As fully established above, the composite mark REWARDTV is suggestive of Applicant’s services since it is not readily recognizable as describing a particular characteristic of Applicant’s services; and since imagination, thought or perception is required to reach a conclusion about applicant’s services offered under the mark.

Accordingly, it is respectfully requested that the refusal pursuant to §2(e)(1) of the Trademark Act, 15 U.S.C 1052(e)(1) be reversed.

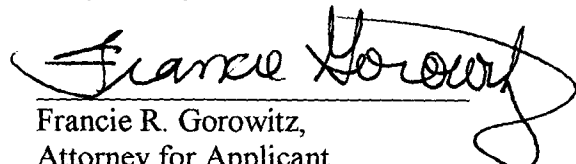
Date: July 14, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail addressed to Assistant Commissioner for Trademarks, United States Patent and Trademark Office, Box TTAB-NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513 on July 14, 2003.


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Respectfully submitted,


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